

Remarks

Claims 1-22 are pending in the present patent application. No claims have been added, cancelled or amended. No new matter has been added.

Claim rejections - 35 USC §112

The Examiner rejected claims 1-22 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner stated:

Claims 1 and 12 recites "extracting only a plurality of last bits" and "extracting only a plurality of first bits". It is unclear from the claims, what constitutes "plurality of last bits" and "plurality of first bits". These limitations in the respective claims can be interpreted such as anything except for first bit being "plurality of last bits" and anything except for last bit being "plurality of first bits". The resulting claims does not clearly set forth the metes and bounds of the patent protection desired, thus making the claims 1 and 12 vague and indefinite.

The specification in paragraph 0026 and 0027 recites the support "such as last 8 bits" and "such as first 8 bits" but does not set forth the metes and bounds of the total number of bits. Further emphasizing the situation when the total number of bits are 8, and as per the specification, if the last 8 bits were extracted, the last 8 bits would be all 8 bits, and, if the first 8 bits were extracted, first 8 bits would be all 8 bits, thus making the claims 1 and 12 vague and indefinite.

The resulting claims does not clearly set forth the metes and bounds of the patent protection desired, thus making the claims 1 and 12 vague and indefinite.

Contrary to the examiner's assertion, the recited phrases "*extracting only a plurality of first bits*" and/or "*extracting only a plurality of last bits*" are neither vague nor indefinite for at least the following reasons. As stated in MPEP § 2173.01 Claim Terminology:

A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention so long as any special meaning assigned to the term is clearly set forth in the specification. See MPEP § 2111.01. < Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), claims may not be rejected solely because of the type of claim language used to define the subject matter for which patent protection is sought. MPEP § 2173.01 Claim Terminology.

The Examiner has not shown that any of the language or terms of the claim recitations in question contain any terms having any special meanings that are not clearly set forth in the specification. In fact, the Examiner pointed to portions of the specification providing support for the claim recitations in question. In addition, the Examiner demonstrated that he was able to ascertain the scope of the claim recitations in question with a reasonable amount of clarity and precision by articulating at least one definition of the boundaries of the scope of the claim recitations in question. For example, the Examiner admitted that the specification teaches "such as last 8 bits" or "such as first 8 bits". However, nothing in the specification limits the number of bits to only 8 total bits. In the case where the number of bits is 12 bits, for example, then, as taught in the specification, 8 bits may be extracted and 4 bits may not be extracted. Even in an example where the number of bits is 8, the claimed recitations may result in 8 bits being extracted, which is consistent with the specification, and there is nothing vague or indefinite with such an example. Again, the Assignee kindly directs the Examiner's attention to MPEP § 2173.01 which states the proposition that applicant's are their own lexicographers.

Furthermore, as discussed below, the Assignee kindly reminds the Examiner of the principle recited in MPEP § 2173.03 that the Examiner should allow for a reasonable amount of latitude in the precision of the claim language. As discussed in MPEP § 2173.02 Clarity and Precision:

The examiner's focus during examination of claims for compliance with the requirements for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirement for clarity and precision [emphasis added], not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable [emphasis in original] degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire [emphasis added]. Examiners are encouraged to suggest claim language to applications to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity [emphasis added]. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. [Emphasis added].

In reviewing the claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph [emphasis added], >by providing clear warning to others as to what constitutes infringement of the patent<. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283

(Fed. Cir. 2000). Se also *In re Larsen*, No. 01-1092 (Fed. Cir. May 9, 2001)(unpublished). MPEP § 2173.02 Clarity and Precision.

Thus, the Assignee respectfully asserts that the Examiner has failed to consider the claims as a whole to determine whether one of ordinary skill in the art would be apprised by the claims of the scope of the claims. The Assignee kindly points out that such a consideration is not optional but is mandatory since MPEP § 2173 requires that the Examiner must make such a consideration. Furthermore, the Examiner himself in his rejection has in fact shown that one of ordinary skill in the art would be apprised of the scope of the claims and the meaning of the recitations in question. For example, the Examiner stated:

The specification in paragraph 0026 and 0027 recites the support "such as last 8 bits" and "such as first 8 bits" but does not set forth the metes and bounds of the total number of bits.

Taken in consideration with the Examiner's following statement:

These limitations in the respective claims can be interpreted such as anything except for first bit being "plurality of last bits" and anything except for last bit being "plurality of first bits".

it is clear that the Examiner understood that specifying the total number of bits is unnecessary since the Examiner demonstrated he was still able to interpret the scope and bounds of the recitations, in one particular embodiment, even in the absence of the total number of bits being recited.

Thus, the Examiner pointed to sections of the specification to help explain and give an example of what the scope of the recitations is, thereby showing that the claims satisfy at least part (A) of the above recited determination. Furthermore, the Examiner himself in his rejection demonstrated that he understands what the scope of the claims and claim recitations are by explaining at least one interpretation of the meaning, definition and or scope of the recitations, thereby showing that the claims satisfy at least part (C) of the above determination. In fact, the Examiner articulated with clarity and precision at least one interpretation of the scope of said claims.

Therefore, it is respectfully submitted that the claims and the recitations in question are not vague and indefinite, and the Examiner has himself demonstrated this to be the case. In view of the fact that the Examiner articulated the scope of the claims with a reasonable degree of clarity and precision, and further in view of the MPEP's instructions to the Examiner that "Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire . . ." the rejection should be withdrawn.

Claim rejections - 35 USC §103(a)

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishizuka, U.S. Patent No. 5,262,873.

Contrary to the Examiner's assertion, nowhere does the patent to Ishizuka teach or disclose, in combination:

obtaining a first correction digital signal by scanning a first correction document during black correction, and extracting only a plurality of last bits of the first correction digital signal; and

obtaining a second correction digital signal by scanning a second correction document during white correction, and extracting only a plurality of first bits of the second correction digital signal

as recited in independent claim 1 and similarly recited in independent claim 12. Nowhere does the patent to Ishizuka teach "black correction". In fact, a text search of Ishizuka, Patent No. 5,262,373, as obtained from the USPTO website was performed, and the phrase "black correction" was not found to exist in said patent. Furthermore, the Examiner did not cite any passage of Ishizuka in support of the assertion that Ishizuka teaches black correction. Thus, contrary to the Examiner's assertion, Ishizuka does not teach "black correction". Furthermore, in support of his argument for obviousness, the Examiner, in making the argument that Ishizuka teaches black correction, stated:

whereas the black correction is done when there is no light source or using a black reference

However, as stated in the present specification in paragraph [0026]

While performing black correction, the scanner uses the lamp to radiate a light on a first correction document

Thus, the Examiner has in fact made the argument that Ishizuka teaches away from the invention as claimed in independent claims 1 and 12 and their respective dependent claims. Even assuming the patent to Ishizuka teaches black correction, which the Assignee asserts it does not, the Examiner argued that Ishizuka teaches no light source during black correction whereas the black correction as defined by the specification utilizes a light source. Thus, since the patent to Ishizuka does not teach all of the elements as claimed in independent claims 1 and 12 and their respective dependent claims, and since the patent to Ishizuka teaches away from the claimed combination, a *prima facie* case of obviousness was not established, and the rejection should be withdrawn.

Conclusion

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

Invitation for a Telephone Interview

The Examiner is invited to call the undersigned attorney, Kenneth J. Cool, at (720) 227-9445 if there remains any issue with allowance.

Respectfully submitted,
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